

Notice of Allowability

Application No.

10/734,919

Examiner

Robert Shiao

Applicant(s)

GILBERT ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to responses filed on 09/22, 2005.
2. ☒ The allowed claim(s) is/are 23-25, now are 1-3.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

1. This application claims benefit of the provisional application: 60/136,579 with a filing date 05/28/1999.
2. Amendment of claim 26, and cancellation of claims 1-22, and 29-41 in the amendment filed on September 22, 2005, is acknowledged. Claims 23-28 are pending in the application.

Responses to Amendment/Arguments

3. Applicant's arguments regarding rejection of claims 23-28 under 35 U.S.C. 102(b) or 103(a) filed on September 22, 2005, have been fully considered and they are persuasive. Since both Kotelko et al. and Kadlubowski do not disclose instant methods of use (i.e., treating autoimmune diseases) using instant compounds of the formula of claim 23, therefore, rejection of claims 23-28 under 35 U.S.C. 102(b) or 103(a) over Kotelko et al., publication, Acta Poloniae Pharmaceutica (1973), 30(2), 135-43, see CAS: 79:105217; or Kadlubowski's publication, Wiadomosci Parazytologiczne (1978), 24(5), 575-9, see CAS: 90:197759, has been withdrawn.
4. Applicant's arguments regarding rejection of claims 23-28 under 35 U.S.C. 112, first paragraph, filed on September 22, 2005, have been fully considered but they are not persuasive. Since the limitation "inactivating antigen-specific T cells" or "a disorder involving an autoimmune component" has not been incorporated into the claims (i.e., claim 23). Therefore, rejection of claims 23-28 under 35 U.S.C. 112, first paragraph, is maintained.

Art Unit: 1626

5. Since claim 29 has been canceled, therefore, rejection of claim 29 under 35 U.S.C. 112, first paragraph, 102(b) or 103(a), is obviated herein.

EXAMINER'S AMENDMENT

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee. Authorization for this examiner's amendment was given in a telephone interview with Benjamin A. Adler on October 20, 2005. The application has been amended as follows:

In Claim 23, lines 1-2, after "A method of", delete "inactivating antigen-specific T cells in an individual in need of such treatment", and insert

--treating an autoimmune disease or a disorder by inactivating antigen-specific T cells in an individual in need thereof, wherein the autoimmune disease or disorder is selected from a group consisting of rheumatoid arthritis, system lupus erythematosus, diabetes, multiple sclerosis, allograft transplantation, and xenograft transplantation--

Delete claims 26-28

Reasons for Allowance

7. The following is an examiner's statement of reasons for allowance:

Claims 23-25 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. This invention relates to derivatives of butyric acid and uses thereof. The closest reference is Gilbert et al. US 6,664,394 or US 6,407,107, which is the parent case of the instant application, discloses derivatives of butyric acid and uses thereof. The difference between Gilbert et al. and instant claims is that the instant claimed methods of use have not been claimed. Suggestion for modification of above record to obtain the instant claimed methods of use has not been found. Claims 23-25 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusions

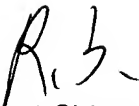
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone

Art Unit: 1626

number for the organization where this application or proceeding is assigned is 703-872-9306.

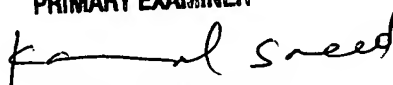
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert Shiao, Ph.D.
Patent Examiner
Art Unit 1626



KAMALA A. SAEED, PH.D.
PRIMARY EXAMINER



Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626

October 20, 2005